

REMARKS

Claims 15-44 are pending in this application with claims 15, 33, 35, 38, and 41-44 being independent. By this Amendment, the specification and the drawings have been amended to correct minor informalities without affecting the claim scope. No new matter has been entered.

In the Office Action, the drawings were objected to because the drawing changes proposed by and described in the Applicant's Request for Approval of Drawing Change filed on March 25, 2002 were not reflected in the drawings submitted therewith. In response, Applicant submits herewith a replacement sheet of drawings, containing revisions to Figs. 7a and 7b, that sufficiently reflect the drawing changes proposed by the March 25, 2002 Request. For example, revised Fig. 7a now depicts intermediate element 120 and element 104 shifted to the right so that axis A1 and film hinge 123 are in line with edge 51, as was originally intended. Similarly, revised Fig. 7b now depicts element 120 shifted to the left with respect to intermediate element 120 and lateral wall 105. Thus, Applicant respectfully requests approval of the proposed drawing changes and reconsideration and withdrawal of the objection to the drawings.

Claims 15-19, 25, 28-31, 33, 34, 41, and 42 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,078,159 to Yuhara ("Yuhara"). As discussed below, Applicant respectfully submits that this rejection should be withdrawn.

Each of independent claims 15 and 33 recites, among other things, "a base ... including a first catch member" and "an intermediate element including a second catch member configured to engage with the first catch member to irreversibly lock the intermediate element to the base." Similarly, independent claims 41 and 42 each recite, among other things, "a base ... including first means for catching" and "an intermediate

element including second means for catching, the first means for catching being engageable with the second means for catching to irreversibly lock the intermediate element to the base.”

As explained below, Yuhara fails to anticipate independent claims 15, 33, 41, and 42 because it does not teach, or otherwise suggest, among other things, the above-mentioned structural configuration of the first and second catch members, that renders an irreversible locking between the intermediate element and the base.

Yuhara discloses a compact case including a receptacle member 10 and a cover member 20 hinged with respect to the receptacle member 10 via a hinge 30. The receptacle member 10 includes a concave notch 15 at its rear end portion, and the hinge 30 is fitted within the notch 15. As best shown in Fig. 2, the receptacle member 10 includes a first engaging member 16 at the interior wall of the notch 15, and the hinge 30 includes a second engaging member 37 engageable with the first engaging member 16. During assembly of the case, the first engaging member 16 is engaged with the second engaging member 37 in order to insert a shaft 31 into the through holes 17, 38. See, e.g., Figs. 2 and 5 and col. 4, lines 48-58. Thereafter, since the case is intended to be packaged with the upper face of the cover member 20 abutting against the bottom face of the receptacle member 10 for display purposes, the second engaging member 37 must be disengaged from the first engaging member 16 by applying a rotational force (i.e., “slightly strong force”) acting upon the hinge 30. See, e.g., col. 5, lines 31-46.

In the rejection statement, the Examiner construed the first and second engaging members 16, 37 of Yuhara as corresponding to the recited first and second catch

members (or first and second means for catching), respectively. As is abundantly clear, however, the engagement between the first engaging member 16 of the receptacle member 10 and the second engaging member 37 of the hinge 30 does not irreversibly lock the hinge 30 to the receptacle member 10. Instead, the first and second engaging members 16, 37 are configured to reversibly lock with each other so as to at least allow rotation of the hinge 30 relative to the receptacle for the display packaging described above.

Nevertheless, while admitting that the engagement between the first and second engaging members 16, 37 is a reversible locking when a “slightly strong force” is applied, the Examiner asserted that, under normal conditions (without defining what the normal conditions would be), the engagement between the first and second engaging members 16, 37 would be an irreversible locking.

Applicant respectfully disagrees with this assertion because, among other reasons, an engagement between two members that is intended to be disengaged in the future, as is the case in Yuhara, must necessarily be, by definition, a reversible locking, not an irreversible locking, regardless of the condition by which the two members are engaged or disengaged. Applicant respectfully submits that the Examiner’s apparent interpretation of the reference is contrary to the art recognized meaning of reversible locking and irreversibly locking. According to Applicant’s understanding, the Examiner is essentially asserting that all locking mechanisms can be considered as providing irreversible locking because even unlockable locking mechanisms provide, in one way or another, a temporary locking until a predetermined condition is applied to unlock them. Ironically, however, the Examiner considered the

engagement between the engaging members 14, 23 as a reversible locking (see page 3, last sentence, of the Office Action), rather than an irreversible locking, even though there is apparently no difference in operational characteristics between the engaging members 14, 23 and the engaging members 16, 37, other than the frequency of the disengagement.

Applicant respectfully submits that an “irreversible” locking plainly refers to, for example, a locking condition between two interlocking members, where the two members are intended to be permanently locked together when they are locked together for the first time. As detailed above, Yuhara fails to disclose or suggest a structural configuration that renders an irreversible locking between the intermediate element and the base, as recited in independent claims 15, 33, 41, and 42.

For at least the reasons set forth above, independent claims 15, 33, 41, and 42 are patentably distinguishable from Yuhara. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 102(b) based on Yuhara.

Claims 27 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Yuhara. Dependent claims 27 and 32 each depend from independent claim 15. As discussed above, independent claim 15 is patentably distinguishable from Yuhara. Thus, at least by virtue of their dependency from allowable independent claim 15, claims 27 and 32 should also be allowable.

Claims 35-40, 43, and 44 were rejected, along with claims 20-24 and 26, under 35 U.S.C. § 103(a) as being unpatentable over Yuhara in view of U.S. Patent No.

4,840,288 to Lunderman et al. ("Lunderman et al."). Applicant respectfully traverses this rejection.

Independent claims 35 and 38 each recite, among other things, "a base ... including a first catch member" and "an intermediate element formed as a single piece with the base and including a second catch member configured to mate with the first catch member." Similarly, independent claims 43 and 44 each recite, among other things, "a base ... including first means for catching" and "an intermediate element formed as a single piece with the base and including second means for catching, the first means for catching being mateable with the second means for catching to lock the intermediate element to the base."

While admitting Yuhara's deficiency with respect to the recited "intermediate element [being] formed as a single piece with the base," the Examiner asserted that, relying on col. 3, lines 7-16 of Lunderman et al., cases with film hinges and cases with pin hinges are functionally equivalent and known in the art and that "it would have been obvious ... to substitute a case molded in a single piece and including film hinges for a case with pin hinges, as this is merely the substitution of functionally equivalent cases and hinge types known in the art." Applicant respectfully disagree with this assertion because, among other reasons, the Office Action fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

The Examiner has the initial burden of presenting a *prima facie* case of unpatentability. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion

or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. M.P.E.P. § 2143. Furthermore, case law in this context indicates that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and that the evidence of a teaching, suggestion, or motivation to combine must be “clear and particular.” As discussed below, the Examiner’s asserted combination of Yuhara and Lunderman et al. fails to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

As to the second criterion, in particular, there is no suggestion or motivation in either Yuhara or Lunderman et al. to combine or modify the asserted teachings of the references in the manner proposed by the Examiner. Lunderman et al. discloses a compact case having a double-pin hinge 16 that pivotally connects a lid 12 and a base 14 of the case. In an alternative arrangement, Lunderman et al. teaches that the hinge 16 (i.e., a link 30) could be pivotally connected to the lid 12 and the base 14 by live hinges, whereby the lid 12, link 30, and base 14 would be formed as a single piece. See col. 3, lines 11-16 of Lunderman et al. Relying on this teaching of Lunderman et al., the Examiner expansively generalized that a case with film hinges and a case with pin hinges are functionally equivalent and that therefore it would have been obvious to substitute a case with pin hinges (i.e., Yuhara) with a case molded in a single piece with film hinges (i.e., Lunderman et al.) because it is a mere substitution of known, functionally equivalent cases. Applicant respectfully disagrees with the Examiner’s reasoning.

Lunderman et al., contrary to the Examiner's assertion, does not teach that any case with a pin hinge is functionally equivalent to any case with a film hinge. Nor does it generalize that any pin hinge may be substituted with any film hinge. Instead, as discussed above, Lunderman et al. merely discloses that, in a particular embodiment, its case may be formed of a single piece with live hinges connecting the lid 12 and the base 14. While such a substitution in Lunderman et al. may not affect the functionality of its cases, that does not necessarily mean that such a substitution is universally applicable in all other compact cases having a pin hinge, because a pin hinge design may have different functional and/or aesthetic characteristics that cannot be substituted or reproduced by a film hinge, rendering such a substitution impractical and/or inappropriate.

For example, one of the main objectives of Yuhara is to improve the appearance of a case having first and second shafts provided on a receptacle member and a cover member, respectively, not by being integrally forming therewith. See col. 1, lines 59-68, of Yuhara. Since the first and second shafts form four holes at the rear end portion of the receptacle member and the cover member, thereby spoiling the appearance of the case, Yuhara provides a first concave notch 15 on the receptacle member 10 to accommodate a hinge 30 and a second concave notch 35 to accommodate a portion of the cover member 20, so as to hide the hinge 30 from exposing on the upper face of the cover member 20 or on the rear end of the receptacle member 10. See, e.g., col. 2, lines 17-22, and col. 5, lines 5-15, of Yuhara. That is, Yuhara's invention is premised upon improving the appearance of a particular type of cases that involve shafts that are separately provided for the receptacle member and the cover member, which

necessarily precludes cases involving an integrally formed receptacle member and the cover member. Therefore, substituting the separately provided hinge 30 of Yuhara with an integrally formed film or live hinge, as proposed by the Examiner, would completely destroy the teachings of Yuhara because to do so would render the Yuhara's teachings completely meaningless.

Moreover, asserting that it is a mere substitution of known, functionally equivalent cases, the Examiner failed to provide any sufficient explanation as to why one of ordinary skill in the art would have been motivated to combine the asserted teachings of the references. Nor has the Examiner provided any evidence to show that modifying the reference or combining reference teachings is in the knowledge generally available to one of ordinary skill in the art. As discussed above, Lunderman et al.'s mere teaching that its case may be formed of a single piece with live hinges would not have provided a sufficient motivation to one of ordinary skill in the art to substitute any pin hinge with any film hinge. Instead, that teaching must necessarily be limited to the particular embodiments disclosed in Lunderman et al.

In view of this limited applicability of Lunderman et al., Applicant respectfully submits that the Examiner's asserted combination is a result of impermissible hindsight gleaned from the present application. When the references are viewed without such hindsight, the asserted combination of Yuhara and Lunderman et al. would not be suggested since there is no "clear and particular" suggestion or motivation to make the Examiner's proposed combination or modification.

For at least the reasons set forth above, Applicant respectfully submits that the second criterion for a *prima facie* case of obviousness has not been met.

As to the third criterion, the asserted combination of Yuhara and Lunderman does not show a reasonable expectation of success because it is unclear as to how the complex structural configuration of Yuhara could be replaced or reproduced by a film or live hinge. For at least these reasons, we believe that the third criterion for a *facie* case of obviousness also has not been met.

For at least the reasons set forth above, Applicant respectfully submits that a *prima facie* case of obviousness has not been properly established. Therefore, Applicant respectfully requests reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a).

Dependent claims 20-24 and 26 depend from independent claim 15. As explained above in the discussion of 35 U.S.C. § 102(b) rejection based on Yuhara, independent claim 15 is patentably distinguishable over Yuhara. Lunderman et al. also does not supply the above-mentioned deficiency of Yuhara. That is, Lunderman et al. fails to disclose or suggest, among other things, “a base ... including a first catch member” and “an intermediate element including a second catch member configured to engage with the first catch member to irreversibly lock the intermediate element to the base,” as recited in independent claim 15. Thus, at least by virtue of their dependency from allowable independent claim 15, dependent claims 20-24 and 26 should also be allowable.

In view of the foregoing remarks, Applicant respectfully requests the reconsideration of this application, the withdrawal of all the outstanding objection and rejections, and the allowance of all pending claims 15-44.

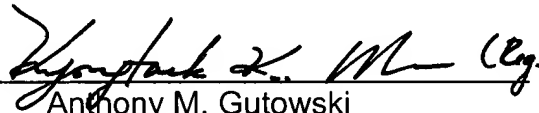

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicant declines to subscribe automatically to any statement or characterization in the Office Action, regardless of whether it is addressed above.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: August 18, 2004

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ATTACHMENT

- One (1) Replacement Sheet of Drawings containing Figs. 6, 7a, and 7b